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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/933,843 | 08/20/2001 | Anthony J. Baerlocher | 0112300-898 | 9181 |
| 29159 | 7590 | 02/15/2006 | EXAMINER | |
| BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135 | | | NGUYEN, BINH AN DUC | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3713 | |

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

The Petition under 37 CFR 1.181 has been granted November 30, 2005, therefore, the Response to Office Action dated April 7, 2004 is hereby considered.

The Response to Office Action dated April 7, 2004 is not fully responsive to the Office Action sent July 30, 2003 because: the amended limitation of "adding a digit to the digits of the original award" (claims 1, 23, and 29) is drawn to a non-elected invention, i.e., non-elected Species G (Fig. 11), as being set forth in the Restriction sent October 2, 2002.

Further, since claims 1, 23, and 29 are generic claims and the introduction of the non-elected species of "adding a digit to the digits of the original award" changes the claims into non-generic, thus the invention has been changed.

Furthermore, the applicant is referred to MPEP 608.01(n)III which set forth the improper amendment.

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining

elements or added still other elements.

In this case, if claim 1 recites the "adding a digit to the digits of the original award," and claim 2 reciting the structure of claim 1 in which "adding a digit to the digits of the original award" was omitted or replaced by "one of different award modification methods includes a rearrangement of said digits of said original award" would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

The same situation is also applied to claims 23 and 29.

Finally, in addition to the changing of original invention, the amended claims are also subjected to the rejection under 35 U.S.C. 112, fourth paragraph, and further, the claims are rendered to be indefinite under 35 U.S.C. 112, second paragraph.

Since the reply filed on December 30, 2003 appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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